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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,301	01/13/2006	Atsushi Kikuchi	Q87762	5170
23373 7590 04/01/2009 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				
EXAMINER AUGHENBAUGH, WALTER				
ART UNIT		PAPER NUMBER		
1794				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/533,301

Applicant(s)

KIKUCHI ET AL.

Examiner

WALTER B. AUGHENBAUGH

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 6-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 14, 2009 has been entered.

Acknowledgement of Applicant's Amendments

2. Applicant's amendments in claim 1 in the Amendment filed January 14, 2009 have been received and considered by Examiner.

Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamada et al. (USPN 4,528,219).

In regard to claim 1, Yamada et al. teach a multilayer preform comprising a layer of a polyester resin that contains ethylene terephthalate units (PET) (col. 11, lines 22-60). Yamada et al. teach that the multilayer preform is formed by compression molding (which is compression forming) (col. 11, lines 47-51). The time is not shorter than 300 seconds before a calorific value of isothermal crystallization of the layer of the polyester resin of the preform of Yamada et al. at 210°C reaches a maximum value because Yamada et al. teach that the preform comprises a layer of a polyester resin that contains ethylene terephthalate units that is formed by compression

molding (col. 11, lines 22-60), which meets the structural and compositional limitations of the claim. The recitation “said preform is formed by compression-forming a molten resin mass” is a method limitation that has been given little patentable weight since the method of forming the article is not germane to the issue of patentability of the article itself. Regardless, the preform of Yamada et al. “is formed by compression-forming a molten resin mass” because the re-heated pipe taught at col. 11, lines 47-49 is a “molten resin mass” because it is a re-heated resin pipe. The resin pipe is a resin mass because it consists of resin.

In regard to claim 2, the polyester resin contains ethylene terephthalate units in an amount of 100%, which is more than 95% (col. 11, lines 22-25 and lines 41-60).

In regard to claim 3, recycled polyester resins fall within the scope of the teaching of Yamada et al. of PET (col. 7, lines 34-38). For example, recycled polyethylene terephthalate is polyethylene terephthalate.

In regard to claim 4, Yamada et al. teach that the preform comprises a layer of a thermoplastic resin other than the layer of polyester resin (col. 11, lines 22-60).

In regard to claim 5, Yamada et al. teach a preform that corresponds to the preform claimed in claim 5 (col. 11, lines 22-60).

Response to Arguments

5. Applicant’s arguments on pages 5-7 of the Amendment regarding the 35 U.S.C. 102 rejection of claims 1-5 have been fully considered but are not persuasive.

Applicant’s arguments are largely based on differences in the method of producing the product of the prior art and Applicant’s method of producing Applicant’s product. However, Applicant has not shown that Applicant’s process of forming Applicant’s product results in

distinctive structural characteristics of the final product as compared to the preform of Yamada et al. MPEP 2113. Applicant has not provided evidence that shows that Applicant's process of forming Applicant's product results in distinctive structural characteristics of the final product as compared to the preform of Yamada et al. The arguments of counsel (for example, "... considerably different...", "... certainly shorter..." [page 6 of Amdt.]) cannot take the place of evidence in the record. MPEP 716.01(c) II.

Applicant argues that only the ends of the pipe are compression formed, but compression forming the ends of the pipe is still nonetheless forming the article by compression forming.

Applicant's statements in the first paragraph of page 7 of the Amdt. do not appear to pertain to the subject matter claimed in Applicant's claim. For example, the claim language does not preclude a "discontinuous" multilayer structure from the scope of the claim.

Conclusion

6. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, THIS ACTION IS MADE FINAL even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is (571) 272-1488. While the examiner sets his work schedule under the Increased Flexitime Policy, he can normally be reached on Monday-Friday from 8:45am to 5:15pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Walter B Aughenbaugh /
Examiner, Art Unit 1794

03/24/09

/Rena L. Dye/
Supervisory Patent Examiner, Art Unit 1794